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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,555	08/30/2001	Brent Gilgen	303.778US1	1835

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER

PERT, EVAN T

ART UNIT PAPER NUMBER

2829

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/945,555	Applicant(s) GILGEN ET AL.	
	Examiner Evan Pert	Art Unit 2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-75 is/are pending in the application.
- 4a) Of the above claim(s) 10,13,24,29-32,38 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,11,12,14-23,25-28,33-37,39-43 and 45-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 52-59, 62-64, 66-67, 70-71 and 73-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 53, there is a lack of antecedent basis for "the first layer".

Claims 52-59, 62-64, 66-67, 70-71 and 73-74 recite an undefined "predetermined shape." Some *examples* of "shapes" are disclosed in the specification, drawings and text. Yet, if the claimed shape is actually important to the invention, applicant should be able to, and *must*, positively recite limitations of the shape, to meet the requirements of 35 USC 112, 2nd paragraph, requiring applicant to specifically point out the distinctive features of the claimed invention.

For purposes of examination, the claimed "predetermined shape" is an ill-defined "substantially cone-shape."

Claims 1, 4-9, 11-12, 14-23, 25-28, 33-37, 39-43, 45-51, 60-61, 65, 68-69, 72 and 75 recite "substantially cone-shaped," which applicant insists clearly describes a range of shapes supported by the specification that are not actually "cone-shaped" by the mathematical or dictionary definition [p. 31-32 response dated 10/10/03].

The plain meaning of "cone-shaped" is the shape of a right triangle rotated around its base [Merriam-Webster].

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As an example of confusion from the phrase "substantially cone-shaped," the shapes of the container capacitor electrodes on the cover of U.S. 5,162,248 would not normally be considered "substantially cone-shaped" to one of ordinary skill in the art, yet meet applicant's argumentative definition [i.e. a cylinder that is narrower toward the bottom as argued at p. 32 of the response dated 10/10/03].

In the '248 patent, the actual photographs purportedly show "substantially cone-shaped" electrodes, but the drawings show a cylindrical electrode. How does one distinguish a "cone-shape" as in the *photographs* of the '248 patent from a seemingly perfectly cylindrical or crown-shape as depicted in the *drawings* of the '248 patent?

As a different example, when one looks to Fig. 3 of Yamamoto et al., one sees a "substantially cone-shaped" electrode because of a cylinder being narrower toward the bottom [i.e. per applicant's argumentative definition of substantially cone-shaped]. Yet, the figures show no taper or narrowing at all. How does one distinguish the "substantial cone-shape" of the claimed invention from the "inherently tapered cylinder" shape of the prior art photographs depicted as perfectly "crown-shaped" or "container-shaped" or "cup-shaped" in the drawings?

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claim 51 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. 6,215,187 [Fig. 25].

Claim 52 is rejected 35 U.S.C. 102(a) as being clearly anticipated by Yamamoto et al. [Fig. 2].

**Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evan Pert whose telephone number is 703-306-5689. The examiner can normally be reached on M-F (7:30AM-3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 703-308-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0956.

ETP  
January 12, 2004

  
**EVAN PERT**  
**PRIMARY EXAMINER**